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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/780,391

02/17/2004

David Wiemer

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EXAMINER

GRAZIER, NYEEMAH

ART UNIT

PAPER NUMBER

1626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/780,391

Applicant(s)

WIEMER ET AL.

Examiner

Nyeemah Grazier

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1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 34-36 and 39-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33, 37 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/17/06, 2/17/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**  
**FIRST ACTION ON THE MERITS**

**I. ACTION SUMMARY**

Claims 1-41 are currently pending. Claims 34-36, and 39-41 are withdrawn from further consideration by the Examiner because said claims are drawn to a non-elected invention. 37 C.F.R. § 1.142(b).

**II. PRIORITY**

The instant application is a Divisional of US Application 10/116,737, filed April 3, 2002, now U.S. Patent number 6,727,234; which claims benefit of US Provisional Application 60/281,170, filed April 3, 2001.

**III. INFORMATION DISCLOSURE STATEMENT**

The information disclosure statements (IDS) submitted on February 17, 2004 and June 17, 2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

**IV. RESTRICTION/ELECTION**

***A. Election: Applicant's Response***

Applicant's election of Group I, claims 1-33, 37 and 38 in the response filed on December 4, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

***B. Status of the Claims***

i. Scope of the Elected Subject Matter

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The applicant has elected the compounds of formula (I) wherein: **X** is oxygen, **R<sub>1</sub>** is 5-(N,N-dimethylaminosulfonyl)naphthyl, **R<sub>2</sub>** is  $-O-P(=O)(-OR_a)-O-P(=O)(-OR_a)_2$ , and wherein **n** is 2.

The search was broadened and therefore examination of the invention now includes the compound of formula (I) wherein **R<sub>1</sub>** is aryl is selected from the group consisting of phenyl, naphthyl, and anthracenyl, which aryl is optionally substituted with one or more substituents independently selected from  $-COOR_b$ ,  $-S(O)_nNR_bR_b$ , halo, cyano, nitro, aryl, (C2-C6)alkenyl,  $-C(=O)NR_bR_b$ ,  $-OC(O)NR_bR_b$ ,  $-NR_bR_b$ , or  $-S(O)_nR_b$ , where each **R<sub>b</sub>** is independently hydrogen, (C1-C10)alkyl, or (C1-C10)alkanoyl; , and where **X**, **R<sub>a</sub>**, and **n** have the original meanings in claim 1.

ii. Non-elected Subject Matter Withdrawn 37 C.F.R. §1.142(b)

The non-elected subject matter are the compounds of Formula (I) wherein:

**R<sub>1</sub>** is "a detectable group" except wherein aryl is selected from the group consisting of phenyl, naphthyl, and anthracenyl, which aryl is optionally substituted with one or more substituents independently selected from  $-COOR_b$ ,  $-S(O)_nNR_bR_b$ , halo, cyano, nitro, aryl, (C2-C6)alkenyl,  $-C(=O)NR_bR_b$ ,  $-OC(O)NR_bR_b$ ,  $-NR_bR_b$ , or  $-S(O)_nR_b$ , where each **R<sub>b</sub>** is independently hydrogen, (C1-C10)alkyl, or (C1-C10)alkanoyl;

**R<sub>2</sub>** is selected from the group in claim 1, EXCEPT  $-O-P(=O)(-OR_a)-O-P(=O)(-OR_a)_2$ .

## V. REJECTION(S)

### A. CLAIM REJECTIONS - 35 USC § 112, FIRST PARAGRAPH

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

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make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-33, 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods for treating diseases such as allergies, allergic bronchopulmonary aspergillosis, etc., does not reasonably provide enablement for the prevention of said diseases.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The relevant factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph have been set forth in In re Wands.

See In re Wands, 8 USPQ.2d 1400 (1988). The factors are as follows:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

The factors relevant to this rejection are limited to the amount of direction or guidance present and the presence or absence of working examples.

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*The Amount of Direction or Guidance Present and the Presence or Absence of Working  
Examples*

The instant inventions are directed to Mevalonic acid derivatives, known collectively as isoprenoids. The compounds of the invention are useful probes for studying the prenylation process and related processes. The specification discloses a narrow synthetic scheme for the preparation of formula (I) wherein X is an amine but does not provide guidance to make the compounds of formula (I) where X is oxygen or sulfur. See, p. 19, Example 1.

**VI. OBJECTION(S)**

*Claim Objection-Non Elected Subject Matter*

Claims 1-3 are objected to as containing non-elected subject matter. To overcome this objection, Applicant amend the claim by deleting the non-elected subject matter.

Recitation of an intended use or utility in the preamble which can otherwise stand alone is not considered a further limitation of the claim and therefore cannot impart patentability to a known composition of matter. See, In re Spada, 15 USPQ.2d 1655 (Fed. Cir. 1990).

Claims 37 and 38 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 2-33, 37, and 38 are object because they depend from a rejected/objected based claim.

**VII. CONCLUSION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:30 a.m. - 6:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. M<sup>o</sup>Kane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Very truly yours,

  
**Nyeemah Grazier, Esq.**

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